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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,664	09/18/2003	Mary Therese Jernigan	71635	8569

7590 06/15/2005

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/665,664

Applicant(s)

JERNIGAN ET AL.

Examiner

Irina S. Zemel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-77 is/are pending in the application.
- 4a) Of the above claim(s) 1-64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 65-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-77 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 1/12/04; 1/19/05
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: IDS 12/22/03

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election with traverse of Invention Group IV, claims 65-77 with respect to Invention Groups I and II in the reply filed on March 25, 2005 is acknowledged. The traversal is on the ground(s) that Invention Groups I, II and IV are capable of being used together. This is not found persuasive because the invention groups I, II, and II while are capable of being used together, namely all products produced in each group can be used together for further processing, or for further use of each of the invention the inventions are not capable of being used together as claimed. The applicants further argue that invention of Groups I pr III are included in the scope of Group IV. This is not found persuasive since the modes of operation of the inventions as claimed are different. Step b of Group I is not required for Group IV, and step a1 of Group III is not required for Group IV. The pipe of Group IV is not required go ether Groups I or III.

The requirement in respect to invention Groups I, II and IV is still deemed proper and is therefore made FINAL.

Claims of the invention Group II are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on March 25, 2005.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the

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unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 65-77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 90-106 and 109-120 of copending Application No. 10/986129. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of copending applications are directed to obvious variations of the present claims, such as polyester would have been inherently melted at the specified temperatures, and the aspect ratio is inherent from the claimed length and diameter of pipes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 65-73 and 756-77 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for polyester polymer, does not reasonably provide enablement for any polymers being recrystallized in a pipe of specified L/D ratio. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The entire disclosure is directed to the polyester polymers and methods of crystallizing polyesters. The disclosure containing virtually no guidance as how to crystallize any other polymers from the wide variety of polymeric substances known in the art (polyamides, polyolefins, polycarbonates, etc., etc.,) It would clearly require undue experimentation to determine which of the polymers known in the art would be capable of thermal crystallization under conditions specified in claim 65 of the instant invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 65-77 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention.

Claim 65 refers to the T<sub>g</sub> of the polyester, however no polyester is recited in claim 65. Various polyester have various T<sub>g</sub>'s, so the claimed T<sub>g</sub> limitation is indefinite.

Claims 69, and 74 recite polyester pellets. It is not clear whether this limitation refers to the pellets recited in the base claim 65, or these claims recite additional steps of introduction of polyester pellets in addition to the pellets recited in claims 65.

Claims 69 recites "further" introduction of solid pellets with a specified degree of crystallinity. It is not clear whether the recited step is in fact, an additional step, or it simply intends to limit the crystallinity of previously recited pellets (in claim 65). If the former is the case, such process steps (additional introduction of pellets with specified crystallinity) is not supported by the specification.

Clarification is requested.

***Allowable Subject Matter***

Claims 65-77 are allowable over the prior art of record.

The following is a statement of reasons for the indication of allowable subject matter: The reasons for allowance are given with the assumption that the intended polymer for crystallization as claimed in claim 65 is limited to polyesters.

While crystallization of polyesters by treating polyesters in liquid medium above the melting point or above T<sub>g</sub> of the polyesters is **notoriously** known in the art, the art of record is deficient in disclosing a crystallization process in long pipes with specified aspect ratios.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel  
Examiner  
Art Unit 1711

A handwritten signature in black ink, appearing to read 'Irina Zemel', written in a cursive style.

ISZ